

REMARKS

Claims 1 - 39 are currently pending in this application. Claims 1 – 20 were withdrawn from further consideration as being drawn to a non-elected invention. The Applicant elected claims 21 – 34 without traverse.

Response to Rejection under 35 USC 103

Claims 21 – 39 were rejected under 35 U.S.C. 103(a) as unpatentable over Rudd et al in view of Bakalar and in view of Dillon. Rudd et al was cited as disclosing a process for molding a bifocal or corrective lens portion using the instant two injection molds. This alleged process included an outer mold forming the body of the lens and inner mold forming the corrective or light magnifying portion. Bakalar was cited as merely showing what the primary reference is already disclosing.

Claim 21, as presently amended, is directed to a method of manufacturing of eyewear having the limitations of injecting heated plastic resins in an outer mold to create an outer lens blank with a first focal power; *injecting heated plastic resins in a inner mold inside the outer mold to create a second lens blank with a second focal power inside the first lens blank*; and dying the first lens blank and the second lens blank with pigmentation to limit light transmittance between ten and forty percent. (emphasis added)

Rudd et al. is directed to a method and apparatus for forming a laminated bifocal lens. The laminated bifocal lens includes a rear prescriptive lens onto which a second lens having a bifocal segment is laminated. The second lens is formed from a female mold 30 having a segment insert 34 received within a bifocal segment cavity 32 *defined as outside the outer lens mold surface 54*. The bifocal segment is formed on the exterior surface of the outer lens not within the outer lens. This is not a lens within a lens process.

The Office Action stated that “Simply because the inner lens is formed on the exterior of the outer lens does not mean that it is not formed within –ie, within the outer borders of –the outer lens.” This statement makes no sense at all. According to Merriam-Webster, **exterior** is defined as *being on an outside surface : situated on the outside*. Merriam-Webster also

defines **within** as in or into the interior : **INSIDE**. The Examiner is respectfully requested to clarify why the dictionary definition of these terms is not applicable. Rudd et al. clearly discloses a first lens with a second lens laminated on the exterior of the first lens, not a first lens having a second lens within or inside of the first lens. Claim 21 has been amended to further clarify that the second lens is inside the first lens.

Bakalar discloses a process for simultaneous molding of polycarbonate lens blanks. Bakalar does not disclose a process for molding an inner lens inside an outer lens.

Neither of these references disclose the limitations of the instant claim. Neither of these references disclose two separate molds, one inside the other. Instead, Rudd et al discloses a mold having a first mold surface 54 and a second mold cavity 32 defined outside the mold surface 54. Bakalar does not even disclose two separate mold surfaces. Thus claims 21 – 26, 32, and 33 are allowable for this reason alone.

The Office Action acknowledged that neither Rudd et al or Bakalar disclose dye pigmentation and hard metallic coatings on eyewear. Dillon was cited as showing these features. The Office Action stated that it would have been obvious to modify the method of Rudd et al as taught by Dillon to provide “tinting” and metallic coating on the eyewear of Rudd et al to arrive at the claimed invention. Further, the Office Action stated that “Hence, coating in a sufficient amount “to disguise” the focal power would certainly have been obvious for the additional aesthetic effort such would have provided.”

Dillon discloses mirror coated sunglasses that are scratch and abrasion resistant. Dillon does not disclose using mirror coating on prescriptive eyewear. Dillon is not concerned with focal powers of lenses. Thus it would not have been possible for Dillon to coat lens having differing focal powers with hard mirror coatings to disguise the focal powers of the lens. Further, neither Rudd et al or Bakalar are concerned with this problem of disguising the focal powers of the lens.

The Office Action stated that “Dillon does not explicitly teach that the metallic coating is applied to mask the focal powers of the lens segments, this constitutes an intended purpose which the step of coating would perform”. The Examiner stated that “Obviousness does not require that the step be performed for the same reason, as long as some reason exists for perform it.” *Obviousness requires that there must be a motivation for modifying Rudd et al in the manner set forth in the claimed invention.* It is not enough that Rudd et al could be modified

by adding a metallic coating, there must be a motivation for doing so in the manner set forth in the claimed invention, that is to disguise the differences in the focal powers of the two lenses. Since neither Rudd et al. or Dillon are concerned in the least with disguising the focal powers, a person skilled in the art would not have been motivated to combine coating of Dillon with Rudd et al to disguise the differences in the focal power.

None of the prior art references disclose, teach or suggest a coating to disguise the differences in focal powers of multifocal lenses. None of the prior art references disclose, teach or suggest even the need or desirability for disguising the differences in focal powers of multifocal lenses. It is a tenet of patent law that the references must suggest the need for a limitation in order to modify a reference to achieve that limitation. As stated by the Federal Circuit in *In re Fritch*, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992), "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."

In the present instance, there simply is no suggestion of any kind for modifying the lens assembly of Rudd et al to disguise the differences in focal power of the lens assembly. Thus, claims 22 - 39 should be allowable over the prior art for this reason alone.

The Applicant respectfully requests that claims 21 – 39 be allowed in view of the above remarks. The Examiner is respectfully requested to telephone the undersigned if further discussions would advance the prosecution of this application.

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Respectfully submitted,

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